



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,600	03/29/2002	Kei Yamana	Q69170	2994

23373 7590 01/28/2004
SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

EXAMINER

DAVIS, MINH TAM B

ART UNIT PAPER NUMBER

1642

DATE MAILED: 01/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/089,600	YAMANA ET AL.	
	Examiner	Art Unit	
	MINH-TAM DAVIS	1642	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-27 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group 1, Claims 1, 4, 10-13, 17, 21-23, 25, 27, drawn to a human gene having the nucleotide sequence of SEQ ID NO:1, encoding SEQ ID NO:2, an oligonucleotide probe, a pharmaceutical composition comprising an antisense oligonucleotide, a transformant, a method for producing a polypeptide.

Group 2, Claims 1, 5, 10-13, 17, 21-22, 25, 27, drawn to a mouse gene having the nucleotide sequence of SEQ ID NO:3, encoding SEQ ID NO:4, an oligonucleotide probe, a pharmaceutical composition comprising an antisense oligonucleotide, a transformant, a method for producing a polypeptide.

Group 3, Claims 3, 6, 10-13, 17, 21-22, 25, 27, drawn to a rat gene having the nucleotide sequence of SEQ ID NO:5, encoding SEQ ID NO:6, an oligonucleotide probe, a pharmaceutical composition comprising an antisense oligonucleotide, a transformant, a method for producing a polypeptide, classified in class 536, subclass 23.1.

Group 4, claims 7, 19, 24, 26, drawn to a human polypeptide comprising the amino acid sequence of SEQ ID NO: 2.

Group 5, claims 8, 19, 24, 26, drawn to a mouse polypeptide comprising the amino acid sequence of SEQ ID NO: 4.

Group 6, claims 9, 19, 24, 26, drawn to a rat polypeptide comprising the amino acid sequence of SEQ ID NO: 6.

Group 7, claims 14-16, 20, drawn to an antibody to a human polypeptide comprising the amino acid sequence of SEQ ID NO: 2.

Group 8, claims 14-16, 20, drawn to an antibody to a mouse polypeptide comprising the amino acid sequence of SEQ ID NO: 4.

Group 9, claims 14-16, 20, drawn to an antibody to a rat polypeptide comprising the amino acid sequence of SEQ ID NO: 6.

Group 10, claim 18, drawn to a diagnostic kit comprising 1) a human polypeptide comprising the amino acid sequence of SEQ ID NO: 2, and an antibody specific for said polypeptide.

Group 11, claim 18, drawn to a diagnostic kit comprising 1) a mouse polypeptide comprising the amino acid sequence of SEQ ID NO: 4, and an antibody specific for said polypeptide.

Group 12, claim 18, drawn to a diagnostic kit comprising 1) a rat polypeptide comprising the amino acid sequence of SEQ ID NO: 6a, and an antibody specific for said polypeptide.

The inventions listed as Groups 1-12 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

A national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept. When claims to different categories are present in the application, the claims will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories: (1) A product and a process specially adapted for the manufacture of said product; or (2) A product and a process of use of said product; or (3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or (4) A process and an apparatus or means specifically designed for carrying out the said process; or (5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process. If multiple products, processes of manufacture or uses are claimed, the first invention of the category first mentioned in the claims of the application will be considered as the main invention in the claims, see PCT article 17(3) (a) and 1.476 (c), 37 C.F.R. 1.475(b) and (d). Group I will be the main invention. After that, all other products and methods will be broken out as separate groups (see 37 CFR 1.475(d).)

Group I, claims 1, 4, 10-13, 17, 21-23, 27 form a single general inventive concept, having as a special technical feature, the nucleotide sequence of SEQ ID NO:1.

Groups 2-12 are not linked to the single general inventive concept of group 1, because the polynucleotides of groups 2, 3, the polypeptides of groups 4-6, the antibodies of groups 7-9, the polypeptide and antibody thereof of groups 10-12 do not share the same structure as SEQ ID NO:1 of group 1.

Because these inventions are distinct for the reasons given above restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MINH-TAM DAVIS whose telephone number is 703-305-2008. The examiner can normally be reached on 9:30AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ANTHONY CAPUTA can be reached on 703-308-3995. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0916.

Application/Control Number: 10/089,600

Page 6

Art Unit: 1642

A handwritten signature in black ink, appearing to read 'Minh Tam Davis'. The signature is stylized with a large 'M' and a long, sweeping tail.

MINH TAM DAVIS

PATENT EXAMINER

January 06, 2003